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86-1203

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SUPREME COURT OF THE UNITED STATES

October Term 1986

WARREN R. PITTS,
PETITIONER
v.
COMMISSIONER OF PATENTS

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION

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QUESTIONS PRESENTED FOR REVIEW

This petition presents the following questions:

1. May the Federal Circuit apply an improper standard of review by using a "clearly erroneous" test in place of the requirement of "substantial evidence"?

The foregoing question presents the following subsidiary question:

1a. Is it appropriate for the Federal Circuit to apply the "clearly erroneous" standard and fail to review the entire evidence and instead make a piecemeal review that is not supported by the evidence?

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1. Warren R. Pitts, Petitioner.

2. Commissioner of Patents and Trademarks, Respondent.

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IN THE

SUPREME COURT OF THE UNITED STATES

ON THE WRIT OF CERTIORARI

TO THE UNITED STATES COURT OF APPEALS

FOR THE FEDERAL CIRCUIT

Petitioner respectfully requests that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Federal Circuit in its Case No. 86-684. The judgment on the Petition for Rehearing was entered October 23, 1986.

OPINIONS BELOW

The opinion of the Court of Appeals is unreported and is reprinted in the Appendix to this Petition commencing at page 1a.

The Court of Appeals affirmed an unreported decision of the Patent Office Board of Appeals reprinted commencing at page 1a.

JURISDICTION

This Court has jurisdiction over the judgment entered October 23, 1986 by virtue of 28 U.S.C., Section 1254(1).

THE CONSTITUTIONAL PROVISIONS, STATUTES AND RULES INVOLVED

U.S. Constitution, Amendment V

"No person shall ... be deprived, of life, liberty or property, without due process of law ..."

5 U.S.C., Section 706

Scope of review

"...The reviewing court shall---

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(2) hold unlawful and set aside agency action, findings, and conclusions found to be...

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(E) unsupported by substantial evidence in a case...reviewed on the record of an agency hearing provided by statute...

35 U.S.C., Section 101

Inventions patentable

"Whoever invents or discovers any new and useful process...or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title."

35 U.S.C., Section 102

Conditions for patentability;
novelty and loss of right to patent

"A person shall be entitled to a patent unless --

.

.

.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent ..."

35 U.S.C., Section 103

Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the

prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Federal Rules of Appellate Procedure

Rule 16(a)

The Record on Review or Enforcement

(a) Composition of the Record. The order sought to review..., the findings...on which it is based, and the pleadings, evidence and proceedings before the agency shall constitute the record on review...

STATEMENT OF THE CASE

(a) Procedural History

This case originated as an ex parte Appeal under 35 USC 145 from an adverse decision by the Patent and Trademark Office Board of Appeals (Board).

(b) The Invention

The invention is directed to adhesive droplets (elements) that have a "tack" or "stickiness" level sufficiently high to provide good adhesion to common surfaces and sufficiently low to allow ready removal from a support sheet without sticking to the fingers of the user.

The invention also concerns a method of applying a resilient adhesive element to a surface by (1) directing compressive force to the element to adhere it to the surface

and (2) removing the compressive force, whereupon the resilient element expands to substantially its original configuration in order to facilitate subsequent removal of the element for later reuse when it has served its initial purpose.

(c) The "Final Decision" By the Board

In a Final Decision on March 12, 1986, the Board said that the Examiner's last communication (Paper No. 28) dropped the rejection of all claims over reference Lester U.S. Patent 3,904,038 which had been cited under 37 CFR 1.196(b).

Accordingly, Lester was no longer considered to be before the Board. The case having been returned for final action, the Board concluded that the original rejections on reference Torrey U.S. Patent 3,741,786 continued to be correct and were affirmed.

(d) The Preliminary Decision of the Board

In an earlier decision dated November 29, 1984 the Board stated that it would sustain all of the Examiner's Rejections.

The Board noted for the independent claims that Appellant had argued there is no teaching in Torrey of a sufficiently low tack level. Appellant also had asserted that Torrey does not teach that an adhesive element expands once applied.

As to the dependent claims, Applicant had argued that Torrey does not disclose the particular adhesive to tackifier proportions of the invention, and that the raised portions of adhesive in Torrey could not be described as "droplets" or "globular". It was also alleged that the amount of filler added to the adhesive to achieve a sufficiently low tack or stickiness was not known in the art.

The Board said it could not subscribe to any of the arguments and that it was in substantial agreement with the Examiner's Rebuttal in the Examiner's Answer, summarized within at pp. 18-23.

The Board noted the Examiner's view that the composition of the invention appears to be essentially the same or not patentably distinguishable from Torrey. Both Appellant and Torrey were said to utilize a mixture of an elastomeric adhesive and tackifier, with only one of Applicant's claims actually reciting a specific range for relative amounts.

While the maximum of Applicant's claimed range was acknowledged to be below Torrey, the Examiner said there is no reason to conclude that the Torrey amount is

necessarily restricted to what is taught in his patent.

The Board continued, it "appears to us" that the adhesive of Torrey "could reasonably be presumed to have the same inherent characteristics" as Applicant's adhesive. This presumption allegedly is supported by the portion of Torrey cited by the Examiner (Column 6, lines 38-41):

> "In addition, the adhesive may be selected for easy removal from the substrate after application such as, for example, by selecting an adhesive having a characteristic which enables it to be balled up and removed."

The Board regarded Appellant's argument on the shape of the adhesive and release layer as bordering on "being frivolous". With Appellant's admission that zinc oxide is a known filler, the Board said

there is no reason to conclude that the amount used by Appellant is not conventional.

The rejection of the claims was affirmed for the reasons given by the Examiner "as amplified" above.

The Board also made a new rejection under 37 CFR 1196(b) on Lester, which was found to be the same as Claims 11 and 12. The Board said the tack possessed by an adhesive capable of being balled does not indicate that the adhesive would stick to the fingers of the user. It was also said there was no evidence in the record to indicate that the tackifier level is critical.

With regard to Applicant's argument on expansion of adhesive material, the Board said it agreed with the Examiner's reasoning that the dot-like masses of the reference are composed of the same elastic material and hence are inherently compressible and expandable.

(e) The Actions in the Patent Office

The Patent Office actions are set forth in paper Nos. 4, 11, 15, 19, 25 and an advisory letter of paper No. 28.

(1) Paper No. 4

In Paper No. 4 (Office Action of January 9, 1978) the Examiner rejected Claims 11 and 12 as anticipated by Torrey (Column 1, line 58 - Column 2, line 7;

Column 2, lines 41-46; Column 3, lines 27-31 and 57-63; Column 4, lines 20-23 and 37-39; Column 5, lines 6-12 and 45-70; Column 6, lines 7-17 and 46-57). The remaining rejections were of now cancelled claims.

(2) Paper No. 11

In Paper No. 11 (Office Action of September 9, 1982) the Examiner rejected Claims 11-13 as unpatentable over Torrey as in Paper No. 4. The Examiner specifically noted that the Torrey discloses that a tackifier modified adhesive can be "balled up and removed" (emphasis added). The Examiner concluded that such a pressure sensitive adhesive would appear to be inherently removable from a carrier sheet by a user without sticking to his fingers.

Claims 16-22 were rejected as unpatentable over Torrey. The Examiner said it was not seen that it would have been unobvious to remove an adhesive element (by pulling) by hand, rather than by pressing (to cause) disengagement. In either event, it was said that the adhesive element would function in precisely the same manner.

It was said that neither method of removal would have a significant effect on the ultimate intended functioning of the adhesive.

(3) Paper No. 15

In a final action (Paper No. 15) mailed Ø3/15/83 the Examiner stated that an advisory action was inadvertently mailed on 12/28/82.

Claims 11, 12 and 23 were rejected as unpatentable over Torrey under 35 USC 102 or 103. Claims 16-22 were rejected as unpatentable by Torrey under 103. The rejections were the same as for Paper No.11. Applicant's response was said to have been carefully considered but not found persuasive.

(4) Paper No. 19

In the Examiner's Answer of December 5, 1983 (Paper No. 19), it was noted that the droplets of the invention are claimed to be characterized by a certain tack level, namely one that is sufficiently high to adhere an object to a surface, but sufficiently low to be readily removed without sticking to fingers.

In his brief description of the reference, the Examiner repeated Paper No. 4. His rejection was a repetition of Paper No. 11.

In commenting on the "first rejection", the Examiner again pointed out that Torrey discloses (Column 6, lines 38-41) that a tackifier-modified adhesive element can be balled up.

With respect to the "second rejection", it was not seen that it would have been non-obvious to remove an adhesive element by hand rather than by pressing disengagement.

In Rebuttal I, the Examiner noted Appellant's admission that the segments in Torrey can be "balled up", and referred to Applicant's statement "this has nothing to do with the initial removal of segments from a release sheet" (emphasis added). The

Examiner's response was that the compositional nature of Torrey's adhesive elements is the same before and after application, so that if they can be "balled up" and removed without sticking after being applied, they can be balled up and removed without sticking before they are applied.

In Rebuttal II, The Examiner noted Appellant's contention that there is no teaching in Torrey of adhesive elements capable of expansion. The Examiner's response was that base polymers forming the pressure sensitive elements of Torrey are inherently elastomeric (alleged to be recognized by Appellant); therefore, the elements are capable of expansion once a compressive force is removed. It was said

that the inherent elastomeric polymers of Torrey can be the same of those of Appellant.

In Rebuttal III, the Examiner quoted Appellant as stating that globular configurations are not suggested by Torrey. The Examiner's response was that Torrey discloses a plurality of non-contiguous raised pressure sensitive segments. This means that the raised portions are separated by some random distance. The precise configuration of the raised segments was said not to be critical so long as there is an interrupted surface separable from a carrier tape. The segments may be in the form of dots. The Examiner stated that an analysis of Torrey which concludes that it is not suggestive of a globular configuration is not to be taken seriously.

Moreover, Appellant was said to refer to his globules and drops as "dots".

In Rebuttal IV, the Examiner stated that Appellant admitted that the use of zinc oxide as a filler is known, but the particular filler range is not known. The Examiner regarded this as a bold assertion, but said there is nothing in the record to indicate that the use of 1-10% of a conventional filler is critical or obtains unexpected results. According to the Examiner, one must conclude from the record, that the use of 1-10% zinc oxide is an obvious variant of Torrey.

In Rebuttal V the Examiner noted Appellant implies there is something critical in the use of 50% tackifier, as compared to Torrey's use of 60 parts tackifier. The Examiner agrees that 50% tackifier may or may not correlate with 60 parts tackifier. He states that Appellant "nowhere states" that 50% or less tackifier is critical, except he so speculates in his Brief and a claim.

The Examiner said that Torrey is not limited to tackifier concentrations greater than 50%, although his only specific disclosure is an example containing 40 parts by weight of ethylene vinyl acetate copolymer, 60 parts by weight of a rosin ester as a tackifier, and 0.05 parts by weight of a butylated hydroxy toluene as a stabilizer. This is said not to delimit the

disclosure since the addition of conventional pressure sensitive adhesive "adjuvants" would lower the percentage of tackifier. The Examiner went on to state that the adhesive elements of Torrey may come into contact with the skin, or the finger, without sticking when the finger is rolled over so it is not seen that there is necessarily any distinction between the adhesive elements of Torrey and those of the claims on appeal.

(5) Paper No. 25

In Paper No. 25 mailed 07/15/85, the Examiner rejected Claims 11 and 12 as anticipated by Lester and Claims 16-23 as unpatentable over Lester. The basis was the decision of the Board of Appeals on November 29, 1984.

The Examiner stated that the showing of facts in Appellant's response of January 3, 1985 did not differ in a meaningful way from the showing at the time of the new ground of rejection by the Board, consequently a final rejection was necessitated.

In particular, the showing of fact in Applicant's supplemental response did not establish conception of the invention prior to the filing date of Lester. What is critical to Lester is a tack level which is sufficiently low to permit ready removal by a user without sticking to the fingers. This was said to be absent from evidence submitted and unaccompanied by evidence of diligence.

(6) Paper No. 28

In Paper No. 28 of 07/12/85, the Examiner considered Applicant's response of November 20, 1985 and found it non-persuasive. An Exhibit was said to be non-convincing since no date of origin has been correlated with the original case. The disclosure in the Application was said not to show a tack level that permits ready removal from the sheet by a user without sticking to fingers. The Examiner also stated that just because Applicant's elements can be removed by manually lifting and moving from one site to another, this does not mean that they do not have significant stickiness to the fingers of the user. In particular, the Examiner said that there is nothing in Applicant's evidenciary

presentation to support the use of adhesive drops having the specific peel strength specified by Lester.

In addition, the Examiner said that none of Applicant's Exhibits provide evidence with respect to the tack level of the Lester patent.

Moreover, according to the Examiner, no interference with Lester could be established because the claims are "unpatentable to applicant" in view of Torrey. Accordingly, the rejection of Claims 11, 12 and 16-23 "as being anticipated by or unpatentable over the disclosure of Lester is no longer being maintained".

(f) Apparent Findings of Fact

No findings of fact have been designated as such. It appears that the

following findings of fact were made or implied:

1. Torrey discloses a tackifier modified adhesive that can be balled up and removed.

2. The adhesive elements in Torrey are applied by pressing to cause disengagement from their carrier.

3. The adhesive elements in Torrey are raised pressure-sensitive segments.

4. The adhesive elements of the invention are claimed to be characterized by a certain tack level which is sufficiently high to adhere an object but sufficiently low to permit ready removal.

5. Zinc oxide as a filler is known.

6. The base polymers of Torrey are inherently elastomeric.

7. Applicant's claims 11 and 12 are the same as in Lester.

(g) Appare t Conclusions

No conclusions have been designated as such. It appears that the following conclusions were reached:

1. The pressure sensitive adhesive in Torrey would appear to be inherently removable without sticking.

2. The adhesive elements in Torrey function in the same manner as the invention.

3. The use of 1-10% zinc oxide is an obvious variant of Torrey.

4. The instant claims are obvious over Torrey.

(h) The Decision of the Federal Circuit

The Federal Circuit affirmed (2a) the Examiner's final rejection of claims 11, 12

and 13 under Section 102 (pages 4 and 5 above) and of claims 16-33 for obviousness under Section 103 (pages 5 and 6 above).

The Court considered it meritless to argue that sole reference Torrey is from a nonanalogous art. Torrey was said to be analogous because "it relates to the same field of endeavor as the claimed subject matter."

As to the argument that reference Torrey does not suggest an adhesive element that expands upon removal of compressive force, the Court noted that the Board had found expansion inherent in Torrey and that Applicant had not proved otherwise, and that the finding of inherency was not clearly erroneous, citing In re Caveney, 761 F.2d 671, 674, 226 USPQ 1, 3 (Fed. Cir. 1985).

As to the argument that Torrey does not suggest the tackifier limitation claims 21 and 22, the Court stated that no evidence had been presented that this limitation is critical.

The argument as to claims 17 and 18, that Torrey shows dots of adhesive rather than globs, was said to fail in that only the speculation of the attorney had been presented and is entitled to no weight.

With respect to the zinc oxide limitation of claim 22, this admittedly is not taught by Torrey, but the Court said it could find no error in the Board's conclusion that it would have been obvious to use a zinc oxide filler in Torrey, despite the absence of any teaching, suggesting that this should be done.

The Court further found no error in the Board's conclusion that claims 11, 12 and 23 were anticipated (Section 102) by Torrey. The Board's finding of inherency in Torrey on the tack level limitation was said to be not clearly erroneous. The Argument that a binding adhesive, i.e., to stick two items together, would stick to the fingers was said to be "wholly meritless".

The Court also stated that it was unpersuaded that claims copied from the Lester patent showed that the claims are patentable because Torrey was not of record in the Lester prosecution.

REASONS FOR GRANTING OF THE WRIT

The Court should issue the writ of certiorari in this case because the Federal Circuit made the following errors:

1. It failed to apply the correct standard of review for agency determinations which is "substantial evidence", instead of the "clearly erroneous" standard, which was misapplied.

2. It did not find "substantial evidence" or properly apply the "clearly erroneous" standard to the apparent findings and conclusions in this case.

3. It failed to require specific findings pursuant to FRAP 16(a).

4. It erroneously ignored the patentability of claims copied from Lester as to when reference Torrey is nonanalogous art.

5. It failed to apply the correct test for "nonanalogous art" and "inherency".

I. THE FEDERAL CIRCUIT MISAPPLIED AN INCORRECT STANDARD OF REVIEW; THE PROPER STANDARD IS "SUBSTANTIAL EVIDENCE" AND NOT THE "CLEARLY ERRONEOUS" STANDARD THAT IT MISAPPLIED.

The opinion notes (3a) that the Board's factual finding of inherency "is not clearly erroneous" citing In re Caveney, 761 F.2d 671, 674, 226 USPQ 1, 3 (Fed. Cir. 1985). The specific citation to page 674 F.2d and 3 USPQ states: "

> In appeals from PTO rejectons, the Federal Circuit does not find facts de novo, but, instead, reviews PTO findings under the clearly erroneous standard. See In re Wilder 736 F.2d 1516, 1520, 222 USPQ 369, 372 Fed. Cir. 1984). Under this standard of review, PTO findings are overturned only if the court is left with the definite and firm conviction that a mistake has been made. See SSIH Equipment S.A. 718 F.2d at 381, 218 USPQ at 692. (Emphasis added).

"PTO" refers to the Patent and Trademark Office which is an administrative agency of the United States Government. The proper standard is set forth in 5 U.S.C. Section 706 and requires findings to be set aside if not supported by "substantial evidence". The Federal Circuit has previously acknowledged that the standard commonly associated with a review of agency determinations is "substantial evidence". SSIH Equipment S.A. v. U.S. Inc. Inter'l Trade Comm., 713 F.2d 365, 381, 218 USPQ 678, 692 (Fed. Cir. 1983).

This Court in Universal Camera Corp. v. NLRB, 340 U.S. 474 (1951) stated that:

> "[s]ubstantial evidence is more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion." Consolidated Edison

> Co. v. Labor Board, 305 U.S. 197, 229. Accordingly, it "must do more than create a suspension of the existence of the fact to be established. ***it must be enough to justify, if the trial were to a jury, a refusal to direct a verdict when the conclusion sought to be drawn from it is one of fact for the jury." Labor Board v. Columbian Enameling & Stamping Co., 306 U.S. 292, 300.
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> The substantiality of evidence must take into account whatever in the record fairly detracts from its weight. This is clearly the significance of the requirement ... that courts consider the whole record. Committee reports and the adoption in the Administrative Procedure Act of the minority views of the Attorney General's Committee demonstrate that to enjoin such a duty on the reviewing court was one of the important purposes of the movement which eventuated in that enactment.

In the present case the Federal Circuit not only failed to apply the "substantial evidence" standard, it incorrectly applied

the clearly erroneous standard, by failing to review the entire evidence and by failing to take into account whatever detracts from its weight. The test by the Federal Circuit in In re Caveney, page 34, supra, conspicuously omits the obligation to consider the entire evidence. This requirement has been set forth by the Court in United States v. United States Gypsum Co., 353 U.S. 364, 395, 76 USPQ 430, 443 (1948):

> A finding is "clearly erroneous" when although there is evidence to support it, the reviewing court on the entire evidence is left with the definite and firm conviction that a mistake has been committed. (Emphasis added).

The following sections demonstrate that the Federal Circuit did not consider the entire evidence and did not take into account whatever detracts from its weight.

II. REFERENCE TORREY TAKEN IN ITS ENTIRETY DOES NOT TEACH OR SUGGEST APPLICANT'S METHOD OF DIRECTING COMPRESSIVE FORCE TO A RESILIENT ADHESIVE ELEMENT THROUGH AN OBJECT ATTACHED TO THE ELEMENT AND THEN REMOVING THE FORCE TO PERMIT THE RESILIENT ELEMENT TO EXPAND WITH THE DISTINCTIVE RESULT THAT THE ELEMENT IS TEMPORARILY ATTACHED TO A SURFACE

There is no teaching whatsoever in Torrey of the claims that once an adhesive element is applied, and the compressive forces removed, the element expands for the temporary attachment of an object to a surface.

The Examiner has stated: "It is not seen that at the time of Applicant's invention it would have been nonobvious to one of ordinary skill in the art to have removed the adhesive element from the Torrey substrate by hand rather than by pressingly disengaging the element from the carrier substrate".

The Examiner's statement does not address the question of whether there is a teaching in Torrey that the element expands once the applied compressive force is released. There is no such teaching in Torrey and the method claims which rely on the expansion feature, following the removal of the initial compressive force, are patentable.

In the only example given in Torrey (Column 5, beginning at line 64) the pressure-sensitive adhesive formulation comprises 40 parts by weight of a vinyl ethylene acetate copolymer, and 60 parts by weight of a rosin ester tackifier, and 0.05 part by weight stabilizer. The word "elastomeric" is conspicuous by its absence in Torrey. It is never mentioned. Thus, in the case of Torrey, the major portion of the

composition is tackifier, namely more than 60 per cent. This is by contrast with the present invention, where there is no more than 50% tackifier so that the resultant compositions is an elastomer. It would appear that it is the reduced amount of tackifier in the case of the invention as compared with Torrey that achieves one of the advantages set forth in the claims under consideration, namely the expansion of the resilient elements after removal of compressive force to achieve the temporary attachment of an object to a surface.

III. THE APPARENT FINDINGS AND THE SUBORDINATE CONCLUSIONS AFFIRMED BY THE FEDERAL CIRCUIT ARE EITHER ERRONEOUS OR IRRELEVANT.

With respect to the claims, it appears that the following findings have been made:

1. Torrey discloses a tackifier modified adhesive that can be balled up and removed.

MERELY BECAUSE A TACKIFIER MODIFIED ADHESIVE CAN BE "BALLED UP" DOES NOT MEAN THAT IT EXPANDS AFTER BEING COMPRESSED, TO THE CONTRARY, IF IT IS "BALLED UP" IT CANNOT EXPAND.

> 2. The adhesive elements in Torrey are applied by pressing to cause disengagement from their carrier.

MERELY BECAUSE ADHESIVE ELEMENTS ARE APPLIED BY PRESSING TO CAUSE DISENGAGEMENT DOES NOT MEAN THAT THEY EXPAND AFTER BEING COMPRESSED.

> 3. The adhesive elements in Torrey are raised pressure sensitive segments.

MERELY BECAUSE ADHESIVE ELEMENTS IN TORREY ARE RAISED PRESSURE SENSITIVE SEGMENTS DOES NOT MEAN THAT THEY EXPAND AFTER BEING COMPRESSED.

5. Zinc oxide as a filler is known.

MERELY BECAUSE ZINC OXIDE AS A FILLER IS KNOWN DOES NOT MEAN THAT ADHESIVE ELEMENTS CONTAINING ZINC OXIDE EXPAND AFTER COMPRESSION.

6. The base polymers of Torrey are inherently elastomeric.

EVEN IF THE BASE POLYMERS OF TORREY ARE ELASTOMERIC THIS DOES NOT MAKE THE PRESSURE SENSITIVE COMPOSITION OF TORREY ELASTOMERIC SINCE THE COMPOSITION HAS A MAJOR PORTION OF TACKIFIER.

It also appears that the following subordinate conclusions have been made.

1. The pressure sensitive adhesive in Torrey would appear to be inherently removable without sticking.

THIS STATEMENT HAS NO SIGNIFICANCE. HOW DOES THE PRESSURE SENSITIVE ADHESIVE APPEAR TO BE REMOVABLE WITHOUT STICKING ?

2. The adhesive elements in Torrey function in the same manner as the invention.

THIS STATEMENT HAS NO SIGNIFICANCE. IN WHAT WAY DO THE ADHESIVE ELEMENTS FUNCTION IN THE SAME MANNER?

3. The use of 1-10% zinc oxide is an obvious variant of Torrey.

THIS STATEMENT HAS NO SIGNIFICANCE. HOW DOES THE USE OF 1-10% ZINC OXIDE APPEAR TO BE AN OBVIOUS VARIANT IN TORREY, WHICH DOES NOT DISCLOSE OR SUGGEST THE USE OF ZINC OXIDE IN ANY FASHION WHATSOEVER?

4. The instant claims are obvious over Torrey.

THIS STATEMENT HAS NO SIGNIFICANCE. HOW ARE THE INSTANT CLAIMS OBVIOUS OVER TORREY?

IV. THE FEATURES OF THE DEPENDENT CLAIMS ARE NOT DISCLOSED OR SUGGESTED BY REFERENCE TORREY TAKEN IN ITS ENTIRETY.

One dependent claim requires resilient adhesive elements that have a globular configuration. This kind of configuration, while advantageous to the invention, is contrary to the objective in Torrey and accordingly this claim is not suggested by Torrey.

In another claim the globular configuration is formed by dispensing the adhesive elements in droplet form. Here again, there is no suggestion of this procedure in Torrey.

A further claim specifies that the adhesive element is formed by a mixture of elastomeric adhesive and a tackifier that permits the resilient adhesive element to

expand and temporarily attach the object to the surface. This is not suggested by reference Torrey.

Another claim requires an adhesive selected from a class consisting of butyl rubber, styrene butadiene block copolymers, isoprene styrene copolymers and ethylene vinyl acetate copolymers. These adhesives are in the context of using an amount that permits expansion which is not taught or disclosed in the reference Torrey.

A further claim requires that the tackifier be in the range from 30-50% of the total mixture. As noted above, it may well be that the reduced amount of tackifier used in the invention is responsibile for Applicant's advantages. There is no suggestion at this level of tackifier in the reference.

With respect to a claim on the use of zinc oxide, a known filler, the particular filler range of from 1-10% is not known in the art and is not taught by any reference.

V. REFERENCE TORREY DOES NOT DISCLOSE OR SUGGEST ADHESIVE DROPLETS HAVING A TACK LEVEL SUFFICIENTLY HIGH TO PROVIDE GOOD ADHESION AND SUFFICIENTLY LOW TO ALLOW READY REMOVAL WITHOUT STICKING TO THE FINGERS OF A USER.

Contrary to other claims the specific teaching in Torrey is that his pressure-sensitive elements are for the bonding of substrates, as for instance, where the adhesive "is employed to bind thin sheets of paper" (emphasis added).

There is no teaching anywhere in Torrey that the tack level of the segments should be sufficiently low that the segments are readily removed from a release sheet without

sticking to the finger of the user. In fact, Torrey does not contemplate any usage by the fingers at all. He says his segments are "transferrable" to a substrate by the application of pressure to the transfer tape sufficient to form a bond of the pressure-sensitive segments to the substrate

The Examiner responded to this argument and has been affirmed on the basis of the disclosure in Torrey that pressure sensitive adhesive can be "balled and removed" after being applied. This has nothing to do with the initial removal of segments from a release sheet. In any case, in order for Torrey's adhesive to be "ballable" it must have sufficient tack to form the ball. If the adhesive has that much tack it would also stick to the fingers of the user attempting to remove the segments from the release sheet.

Specific reference has been made to various passages in Torrey. These are discussed and distinguished below.

The first passage states:

> "It has now been found that the problems attendant to prior art adhesive transfer tape constructions may be overcome by a transfer tape construction in which there is applied to the release surface on a carrier tape a plurality of substantially non-contiguous, raised pressure sensitive segments. In this construction, any amount of the pressure sensitive adhesive carried by the transfer tape can be transferred to a substrate by the application of pressure without cutting of the transfer tape or the carried pressure sensitive adhesive.
>
> "In particular, the pressure sensitive adhesive transfer tape construction of this invention comprises a carrier tape which has at least release zones or a release coating on at least one of its surfaces, a plurality of substantially non-contiguous raised pressure sensitive adhesive segments along the length of the transfer tape, and in adhesive contact with the release zones or

> coating, the segments being transferrable to a substrate by the application of pressure to the transfer tape sufficient to form a bond of the pressure sensitive segments to the substrate which exceeds the bond to the release zones or coating on the carrier tape (emphasis added).

The next passage states: "Figure 1 is an illustration of a transfer tape construction of this invention in which the width of the applied substantially non-contiguous raised pressure sensitive segment, illustrated as raised dots, are not coextensive with the width of the carrier tape to provide borders at the edges of the tape".

The third passage states as follows: "As used herein, the term 'a plurality of substantially non-contiguous raised pressure sensitive segments' is meant segments, the

raised portions of which are separated from other pressure sensitive adhesive segments by some selected of random distance as well as pressure..."

The fourth passage states: "The precise configuration of the raised segments employed in the transfer tape construction of this invention is not narrowly critical so long as there is provided an interrupted pressure sensitive adhesive surface separable from the carrier tape by the application of pressure without the necessity of adhesive rupturing or cutting. The segments may, for instance, be in the form of the dots, diamonds, or bars shown in the Hachel drawing, or have..."

The next passage states: "substantially non-contiguous raised pressure sensitive adhesive segments 14 shown here as having the form of a dot or cone. Beneath each pressure sensitive adhesive segment or over at least that portion of the carrier tape bearing" (emphasis added).

The next passage states: "The nature of the carrier tape 12 may vary widely and may, for instance, be paper, cellulose acetate, a polyolefin, a polyester or the like."

The next passage states: "With reference to Figure 3, yet another method of assuring that the pressure sensitive adhesive segments will remain on the under surface of the carrier tape there may be applied to the opposed or upper surface of

the carrier tape, a backside 20 whose bond strength to the pressure sensitive adhesive segments 14 is less than the bond strength of the pressure sensitive adhesives 14 for the release coating 16 on the carrier tape 12."

The next passage states:

> "The pressure sensitive adhesive transfer tape construction of this invention with its characteristic substantially non-contiguous raised pressure sensitive adhesive segments may be fabricated using any conventional pressure sensitive adhesive having an affinitive for the substrate(s) to which the adhesive is to be applied or secured. In general, the pressure sensitive adhesives comprise some base polymer or combination of polymers, tackifiers, plasticizers and, where desired, stabilizers such as anti-oxidants.
>
> Illustrative, but no wise limiting of the base polymers which may be used in formulating pressure sensitive adhesive there may be mentioned polyisobutylene, styrene, butadiene copolymers, ethylene-vinyl acetate copolymers and the like.

Illustrative of tackifiers which are selected for their compatability with the desired base polymer, there may be mentioned terpene resins, rosins, rosin esters, indene resins, alkyl substituted aromatic resins and the like.

As an anti-oxidant for stabilizing there may be mentioned butylated hydroxy tolulene and the like.

As one specific example of a pressure sensitive adhesive formulation there may be mentioned a formulation comprising 40 part by weight of an ethylene vinyl acetate copolymer, 60 parts by weight of a rosin ester as a tackifier, and 0.05 part by weight of a butylated hydroxy tolulene as a stabilizer.

The next page by the Examiner is Column 6, at lines 7-17 which read: "In employing these various application techniques, the adhesive may be applied to the carrier tape or web as a melt, emulsion, a polymerizable liquid, a heat fusable powder, or in a solvent solution, the latter forming the pressure sensitive adhesive upon evaporation of the solvent.

While the pressure sensitive adhesive transfer tapes of the invention may be manufactured on an individual basis, they are more

> conventionally manufactured as a wide roll from which the individual tapes are cut using conventional slitting apparatus.
>
> The final passage by the Examiner appears in Column 6, lines 46-51 as follows: "An even more significant advantage of the substantially non-contiguous nature of the applied pressure sensitive adhesive segments is that they function as discrete adhesive segments and therefore any change in dimension due to humidity, temperature or the like remain localized and are not propagated throughout a continuous mass of adhesive."

IT IS APPARENT THAT THERE IS NO SUGGESTION WHATSOEVER IN REFERENCE TORREY OF DROPLETS HAVING A TACK LEVEL THAT IS SUFFICIENTLY LOW TO BE READILY REMOVABLE FROM THE SHEET BY USER WITHOUT STICKING TO THE FINGERS OF THE USER. THE ENTIRE CONTEMPLATION IN TORREY IS OF A TAPE THAT IS APPLIED WITH ADHESIVE ELEMENTS.

Another claim requires a package with droplets entirely in solid form. There are no such droplets either disclosed or suggested by Torrey.

A final claim requires the interposition of droplets between 1st and 2nd release sheets. This is not suggested by Torrey since he does not have droplets.

VI. REFERENCE LESTER U.S. PATENT 3,904,038 PROVIDES COGENT EVIDENCE THAT SOME CLAIMS OF THE INVENTION ARE PATENTABLE

The Board agreed that some claims are the same as in Lester U.S. Patent 3,904,038 "Package of Pressure Sensitive Adhesive Droplets" (emphasis added). It is in U.S. Class 206/447. Torrey, by contrast is "Transfer Tape having Non-Contiguous Pressure Sensitive Adhesive Patterns"

(emphasis added). It is in U.S. Class 117-31. A person of ordinary skill would not regard a teaching on transfer tape as providing guidance on adhesive droplets.

Moreover, the Examiner in Lester evaluated the copied claims and found them patentable in the light of pertinent prior art. This, plus the complete absence of any teaching on tack level as discussed under Point V, above, should resolve any doubt in favor of patentability.

VII. THE APPARENT CONCLUSIONS ARE ERRONEOUS.

It appears that the following conclusions have been made:

1. The pressure sensitive adhesive in Torrey would appear to be inherently removable without sticking.

THIS IS ERRONEOUS BECAUSE TORREY TEACHES THAT HIS COMPOSITION IS FOR BINDING.

2. The adhesive element in Torrey functions in the same manner as the invention.

THIS STATEMENT HAS NO SIGNIFICANCE. IN WHAT WAY DO THE ADHESIVE ELEMENTS FUNCTION IN THE SAME MANNER?

3. The use of 1-10% zinc oxide is an obvious variant of Torrey.

THIS STATEMENT HAS NO SIGNIFICANCE. HOW DOES THE USE OF 1-10% ZINC OXIDE PROVE TO BE AN OBVIOUS VARIANT?

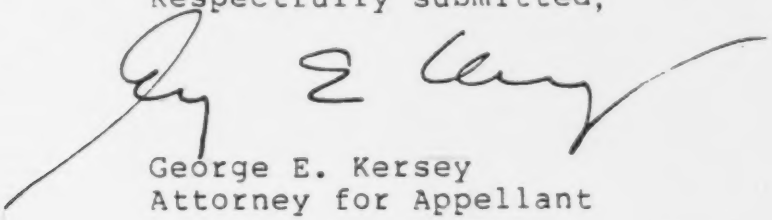
4. The instant claims are obvious over Torrey.

HOW ARE THE INSTANT CLAIMS OBVIOUS OVER TORREY?

CONCLUSION

The Federal Circuit failed to apply the "substantial evidence" test in reviewing an administrative decision. Instead, it misapplied the "clearly erroneous" test by not applying it to the entire evidence.

Respectfully submitted,



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APPENDIX

APPENDIX

UNITED STATES COURT OF APPEALS

FOR THE FEDERAL CIRCUIT

IN RE WARREN R. PITTS) Appeal No.

) 86-1148

Appellant

DECIDED: October 23, 1986

Before NIES, Circuit Judge, NICHOLS, Senior Circuit Judge, and BISSELL, Circuit Judge.

NIES, Circuit Judge.

DECISION

Warren R. Pitts appeals from the decision of the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences affirming the examiner's rejection of claims 11, 12 and 13 for anticipation under 35 U.S.C. Sec. 102 and of claims 16-33 for obviousness under 35 U.S.C. Sec. 103, is affirmed.

OPINION

Pitts's argument that the sole reference Torrey is nonanalogous art is meritless. Torrey is analogous art because it relates to the same field of endeavor as the claimed subject matter. See Union Carbide Corp. v. American Can Corp., 724 F.2d 1567, 1572, 220 USPQ 584, 588 (Fed. Cir. 1984); In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). The mere fact that the Patent and Trademark Office directed the instant application to a different class from Torrey's is irrelevant.

Pitts's principal argument that Torrey does not suggest the methods of claims 16-22 is

that the adhesive element of the claims expands upon removal of compressive force. The Board found that such expansion was inherent in the adhesive element of Torrey, which is made of essentially the same amterial. Accordingly, it was incumbent upon Pitts "to prove that the subject matter shown in the prior art does not possess the characteristic relied upon." In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226,229 (CCPA) 1971). Pitts has made no such effort, and the board's factual finding of inherency, In re Grasselli, 713 F.2d 731, 739, 216 USPQ 769, 775 (Fed. Cir. 1983), is not clearly erroneous. In re Caveney, 761 F.2d 671, 674, 226 USPQ 1, 3 (Fed. Cir. 1985). Pitts's argument that the

Torrey reference does not suggest the methods of claims 21 and 22 is predicated on the notion that the 50% tackifier limitation of those claims results in the expansion of the adhesive element. Pitts has presented no evidence that the 50% limitation is critical or that Torrey's adhesive drops do not expand. Pitts's argument that Torrey does not suggest the methods of claims 17 and 18 because Torrey shows "dots" of adhesive rather than "globs" fails for a similar reason. Pitts has presented nothing but the speculation of his attorney that the globular form is critical. Such arguments are entitled to no weight in determining patentability. See In re Lindner, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972).

Likewise, Pitts offers nothing to show that the 1-10% zinc oxide filler limitation of claim 22 is critical. Pitts admits in his specification that zinc oxide filler is a "[c]onventional ingredient[] of the pressure sensitive tape art." Torrey teaches the use of materials other than tackifier and adhesive. We find no error in the board's conclusion that it would have been obvious to use zinc oxide filler in Torrey's adhesive.

Nor do we see error in the board's conclusion that claims 11, 12, and 23 are unpatentable as anticipated by Torrey. Pitts's principal argument in this regard is that Torrey does not show an adhesive with a

tack level "sufficiently high to provide good adhesion" but "sufficiently low to be readily removed from said sheet by a user without sticking to the fingers of the user." The board's finding that the limitation inherent in Torrey's adhesive is not clearly erroneous. Torrey discloses selection of an adhesive "for easy removal" and "an adhesive having a characteristic which enables it to be balled up and removed." The board's finding that the latter characteristic does not indicate that the adhesive would stick to the user's fingers is not clearly erroneous. Pitts' argument that Torrey's adhesive must stick to the user's fingers "because Torrey teaches that his composition is for binding"

is wholly meritless. That argument reduces to an assertion that all adhesives must stick to the user's fingers, even those adhesives that are easily removable. Pitts has presented no evidence in support of either proposition.

We find unpersuasive all of Pitts's remaining arguments, including the proposition that the patent to Lester (from which Pitts copied his claims 11, 12, and 23) proves that Pitts' claims are patentable. The short answer to that argument is that Torrey was not of record in the Lester prosecution.

In sum, we find no reversible error in the board's opinion and, accordingly, we affirm.

Art Unit 164 Paper No. 30

Appeal No. 578-65

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BOARD OF APPEALS

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Warren R. Pitts

Application for Patent filed October 3, 1977, Serial No. 839,047, a Continuation of Serial No. 512,855 filed October 7, 1974, now Abandoned. Adhesive Elements and Packaging Systems.

George E. Kersey et al. for Appellant.

Primary Examiner - James C. Cannon.

Before Sturtevant, Merker* and Winter, Examiners-in-Chief. Sturtevant, Examiner-in-Chief.

FINAL DECISION

The "Response" filed by Appellant's counsel on October 7, 1985 has only just reached this panel. The delay is regretted.

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* Examiner-in-Chief Rzucidlo having resigned from the Board, a new panel has been constituted replacing him with Examiner-in-Chief Merker. See In re Bose Corp., 772 F.2d 866, 227 USPQ 1, particularly at 227 USPQ 4, first column, the first two full paragraphs, (Fed. Cir. 1985).

The Examiner's last communication (Paper No. 28), to which counsel responded, dropped the rejections of all claims over the Lester patent, which rejections we had made under 37 CFR 1.196(b). This issue is accordingly not before us. The Examiner maintained the rejections of all claims over the Torrey patent under 35 USC 102 and/or103, which rejections we had affirmed.

This case having now been returned to us for final action on the affirmed rejections, we conclude that the rejections on the Torrey reference continue to be correct. We therefore reaffirm them.

The effective date of our affirmance, for purposes of appeal under 35 USC 141 through 145, is the date of mailing of this Final Decision.

Brereton Sturtevant)
Examiner-in-Chief)

Evelyn K. Merker)
Examiner-in-Chief)

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